



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,492	03/09/2001	Stephen Belth	12166-0002	7458
7590	06/23/2004		EXAMINER	
Intellectual Property Group Bose McKinney & Evans LLP Suite 2700 135 North Pennsylvania Street Indianapolis, IN 46204			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 06/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/802,492	BELTH, STEPHEN	
	Examiner	Art Unit	
	John L Young	3622	<i>My/</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 March 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-38 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-9.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

Art Unit: 3622

NON-FINAL ACTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS – 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2. Claims 21, 24 & 36-38 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claim 21, as drafted said claim is not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*,

Art Unit: 3622

167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b) even though said claim is limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999) Note: it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05(q)). The claims at issue suffer from undue breadth.

Claims 24 & 36-38 are rejected for the same reasons as claim 21.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

Art Unit: 3622

are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Marsh (12/08/1998) (herein referred to as (“Marsh”).

As per claim 1, Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows: “A marketing system for communicating with an audience including a targeted individual through a communication system. . . a processor; a database accessible by the processor and including data related to the targeted individual and an identifier; a plurality of audio recordings accessible by the processor; the processor adapted to present the targeted individual with a resource including at least one audio recording selected from the plurality of audio recordings and configured to present the audience with a recording containing marketing information and the at least one tailored portion including at least one audio recording selected from the plurality of audio recordings configured based on at least a portion of the data in the database related to the targeted individual.”

Art Unit: 3622

Marsh lacks an explicit recitation of the elements and limitations of claim 1.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) would have been selected in accordance with the elements and limitations of claim 1, because selection of such features would have provided means *“for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.”* (See March (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

As per claims 2-11, Marsh shows the system of claim 1 and subsequent base claims depending from claim 1.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 2-11.

Marsh lacks explicit recitation of the elements and limitations of claims 2-11.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 2-11 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and

Art Unit: 3622

limitations as found in claims 2-11, because selection of such features would have provided means “*for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.*” (See Marsh (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 12 is rejected for substantially the same reasons as independent claim 1.

As per claims 13-20, Marsh shows the system of claim 12 and subsequent base claims depending from claim 12.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 13-20.

Marsh lacks explicit recitation of the elements and limitations of claims 13-20.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 13-20 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 13-20, because selection of such features would have provided means “*for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting*

Art Unit: 3622

advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.” (See Marsh (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 21 is rejected for substantially the same reasons as independent claim 12.

As per claims 22-26, Marsh shows the method of claim 21 and subsequent base claims depending from claim 21.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 22-26.

Marsh lacks explicit recitation of the elements and limitations of claims 22-26.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 22-26 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 22-26, because selection of such features would have provided means “*for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.”* (See Marsh (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Art Unit: 3622

Independent claim 27 is rejected for substantially the same reasons as independent claim 1.

As per claims 28-31, Marsh shows the system of claim 27 and subsequent base claims depending from claim 27.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 28-31.

Marsh lacks explicit recitation of the elements and limitations of claims 28-31.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 28-31 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 28-31, because selection of such features would have provided means "*for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.*" (See Marsh (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 32 is rejected for substantially the same reasons as independent claim 1.

Art Unit: 3622

As per claims 33-35, Marsh shows the system of claim 32 and subsequent base claims depending from claim 32.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 33-35.

Marsh lacks explicit recitation of the elements and limitations of claims 33-35.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 33-35 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 33-35, because selection of such features would have provided means "*for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.*" (See Marsh (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 36 is rejected for substantially the same reasons as independent claim 1.

As per claims 37-38, Marsh shows the method of claim 36 and subsequent base claims depending from claim 36.

Art Unit: 3622

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 37-38.

Marsh lacks explicit recitation of the elements and limitations of claims 37-38.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 37-38 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 37-38, because selection of such features would have provided means *“for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.”* (See Marsh (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

Art Unit: 3622

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

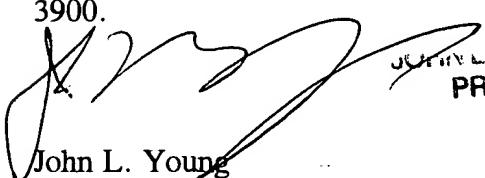
Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



YOUNG, ESQ.
PRIMARY EXAMINER
John L. Young

Primary Patent Examiner

June 22, 2004